

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-5, 9-26, and 30-38 are pending in the present application, Claims 1, 9-11, 16, 30-35, and 38 have been amended, and Claims 6-8 and 27-29 have been canceled without prejudice or disclaimer. Support for the amendments to Claims 1, 16, 32, 34, 35, and 38 is found, for example, in the original claims and figures.¹ Accordingly, no new matter is added.

In the outstanding Office Action, Claims 1-6, 8-24, and 27-35 were rejected under 35 U.S.C. §102(e) as anticipated by Grewal et al. (U.S. Patent No. 6,691,159, hereinafter Grewal); Claim 38 was rejected under 35 U.S.C. §102(e) as anticipated by Hayward et al. (U.S. Patent No. 6,629,134, hereinafter Hayward); and Claims 25, 26, 36, and 37 were rejected as unpatentable over Grewal in view of House et al. (U.S. Patent No. 6,119,247, hereinafter House).

With respect to the rejection of Claim 1 under 35 U.S.C. §102(e) as anticipated by Grewal, Applicants respectfully submit that the amendment to Claim 1 overcomes this ground of rejection. Amended Claim 1 recites, *inter alia*, “wherein the specific form comprises a first part that asks the user to input first information required to identify the device and second information required to specify a working status of the device, and a second part that enables the user to input arbitrary information with regard to the problem.” Grewal does not describe or suggest this element of Claim 1.

The claimed invention realizes the following non-limiting technical advantages from use of the claimed “specific form.” In the online support method of the claimed invention, the specific form may be any form that allows transmission of information with regard to the problem arising in the device. In many cases, fixed pieces of information are required for

¹ For example, see original Claims 6 and 7, and Figs. 1, 2, and 11.

efficient analysis of the problem. In the claimed invention, the first part of the “specific form” gives the typical pieces of information to enhance the efficiency of the analysis of the problem. The second part of the “specific form” gives the detailed information on the problem that can not be covered by the typical information. The arrangement of the “specific form” enables the analysis of the problem and the examination of the effective operation to be carried out more flexibly.

The outstanding Office Action only points to portions of Grewal that describe a user interface when discussing the claimed “specific form.”² The user interface includes various hypertext links as shown in Fig. 5 of Grewal, but the hypertext links shown in Fig. 5 do not describe or suggest the claimed “a first part that asks the user to input first information required to identify the device and second information required to specify a working status of the device.” The outstanding Office Action merely states that Fig. 5 provides for the input of specific information which is generally required for analysis of the problem.³ However, this does not describe or suggest the specific information required to be input into a specific form recited in amended Claim 1.

Amended Claim 1 also recites “obtaining browsing record information, which represents a user's browsing record of the support information, in addition to information input into the specific form.” Grewal does not teach or suggest at least these elements of amended Claim 1.

The outstanding Office Action states that Fig. 4 of Grewal “shows a list of usual destinations therefore inherently some form of browsing record has been obtained.”⁴ Although Fig. 4 shows a “usual destinations” box, Grewal provides no description or discussion about the “usual destinations” box. Therefore, it is not possible for a person of

² Office Action, June 16, 2005, page 3, paragraph 10.

³ Id.

⁴ Office Action, June 16, 2005, page 6, paragraph 25.

ordinary skill in the art to think that the “usual destinations” box of Fig. 4 describes or suggest the claimed “a user’s browsing record of the support information.” Nothing in the “usual destinations” box describes or suggests that the “usual destinations” are support information. Even if the “usual destinations” box of Grewal’s Fig. 4 would be recognized as some sort of browsing record, Grewal does not disclose or suggest how the browsing record is processed.

Furthermore, Applicants respectfully submits that the assertion of inherency is insufficient to show that Grewal inherently teaches the claimed “obtaining” step because the rejection fails to show “that the alleged inherent characteristic necessarily flows from the teachings of the applied prior art”⁵

The Official Action provides insufficient rationale for the finding of inherency. “The fact that a certain result may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic.”⁶ “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’”⁷ Because the Official Action provides an insufficient explanation of why Applicants’ claimed features are inherent, Applicants submit the rejection is improper.⁸

⁵See MPEP 2112 (emphasis in original) (citation omitted). See also same section stating that “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic,” (emphasis in original). See also *In re Robertson*, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) (“[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill,’” citing *Continental Can Co. v. Monsanto Co.*, 948 F2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991); and “[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient,” *Id.* at 1269 (citation omitted)).

⁶ *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1995, 1957 (Fed. Cir. 1993).

⁷ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

⁸ MPEP § 2112, IV “Examiner must provide rationale or evidence tending to show inherency.”

Amended Claim 1 also recites “transmitting the browsing record information and the information input into the specific form to an online support operator.” Grewal does not describe or suggest this element of amended Claim 1.

Grewal describes several alternative types of web-based assistance.⁹ However, Grewal does not describe or suggest multiple assistance. In the claimed invention, multiple assistance is realized because the user is able to transmit *both* the browsing record information and the information input into the specific form to an online support operator. Grewal does not describe or suggest a transmission to an online support operator that includes both browsing record information and information input into the specific form.

Furthermore, House does not cure the above-noted deficiencies of Grewal.

In view of the above-noted distinctions, Applicants respectfully submit that Claim 1 (and dependent Claims 2-5 and 9-15) patentably distinguish over Grewal and House, taken alone or in proper combination. Applicants respectfully submit that independent Claims 16, 32, 33, 34, and 35 (and dependent Claims 17-31, 36, and 37) patentably distinguish over Grewal and House for at least the same reasons as amended Claim 1.

With respect to the rejection of Claim 38 under 35 U.S.C. §102(e) as anticipated by Hayward, Applicants respectfully submit that the amendments to Claim 38 overcomes this ground of rejection. Amended Claim 38 recites, *inter alia*,

obtaining browsing record information from the client in addition to information input into a specific form, wherein the browsing record information represents a user’s browsing record of the support information, and

transmitting the browsing record information and information input into the specific form to an online support operator,

wherein the specific form comprises a first part that asks the user to input specific information, which is generally required for analysis of the problem, and a second part that

⁹ Grewal, cols. 3 and 4.

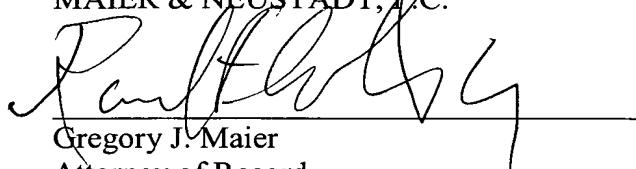
enables the user to input arbitrary information with regard to the problem.

Hayward does not describe or suggest at least these elements of Claim 38.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599

Raymond F. Cardillo
Registration No. 40,440

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

I:\ATTY\JW\205114US\205114US_AM-FILED 10-16-05.DOC